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EXAMINER

BORLINGHAUS, JASON M

ART UNIT PAPER NUMBER

3628

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/822,732	Applicant(s) BAHAR, REUBEN	
	Examiner Jason M. Borlinghaus	Art Unit 3628	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25,28-38,40-45,47-50 and 53-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25,28-38,40-45,47-50 and 53-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 47 is objected to because of the following informalities: misspelling. Claim 47, line 25, states "debt for wkich" instead of "debt for which." Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 – 6, 9 – 11, 16 – 19, 21, 23, 28 – 38, 40 – 45, 47 – 50 and 53 - 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris (US Patent Pub. 2001/0034662) in view of Rivkin (Rivkin, DW, Donovan, DF & Legum, B. *Financial &*

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Cross-Borders Litigation. International Financial Law Review. Euromoney Publications. July 1994. pp. 47 - 51).

Regarding Claim 1, Morris discloses a method of auctioning bad debts to a plurality of clients, said method comprising the steps of:

- placing select information relating to at least one bad debt (debt accounts – see abstract) on an online auction forum (“...a method and system for facilitating a sale preferably using a computer network.” – see page 1, paragraph 0001), said select information (designated information) comprising at least one distinct bad debt item to be displayed on a bidding site of said online auction forum (“Potential buyers are preferably informed when at least some of the designated information has been found in the searching step. In a preferred embodiment, at least a portion of the presale database is uploaded to a computer readable database accessible via a computer network, which may be either an internal network or a global computer network (e.g., the internet).” – see page 4, paragraph 0062 - establishing that information relating to a bad debt item is communicated to the buyer via the internet. While Morris does not use the word “auction”, Morris does state receiving bids (“...receiving one or more purchase orders...” – see abstract and “...bids...” – see page 4, paragraph 0064) and the seller establishing a minimum reserve price (“...seller's minimum reserve...” –see page 4, paragraph 0064), which the

Examiner interprets as including an auction process in Morris's disclosure of a sales method);

- establishing at least one bidding site on said online auction forum, said bidding site being associated with a database, said database including said bad debt item. ("...a computer readable database comprising data pertaining to a plurality of debt accounts..." – see abstract);
- classifying (grouping) said bad debt item based on a geographic territory (region, state or ZIP code). ("The step of grouping the lots preferably further includes the step of receiving from the seller at least one criterion upon which the accounts are to be grouped into lots. (e.g., by region, state or two-digit ZIP code). Similarly, for example, country, province, postal code, city code and other international aggregations may be available to international sellers." – see page 4, paragraph 0059); and
- displaying said bad debt item on said bidding site with said geographic territory. ("The method of the present invention further includes the step of searching the computer readable database for information corresponding to information designated by the potential buyers again, in FIG. 6.

Potential buyers are preferably informed when at least some of the designated information has been found in the searching step." – see page 4, paragraph 0062 – establishing that bad debt items can be searched based upon geography, an already disclosed criterion, and such bad debt items are displayed to the buyer.)

Morris does not teach said method comprising the steps of:

- classifying said bad debt item based on a geographic territory where jurisdiction is present over a debtor.

Rivkin discloses said method comprising:

- geographic territory where jurisdiction is present over a debtor. ("The most common means of enforcing a judgment is by requesting that a court with jurisdiction issue a writ of execution or similar order. Pursuant to such a writ, the real property, equipment, fixtures and personal property of a judgment debtor are seized by law enforcement officers and then sold at a judicially supervised public auction." – see Enforcement of Judgments, paragraph 2 – establishing that jurisdiction is required to be obtained to enforce a judgment against a debtor).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Morris by defining geographic territories by court jurisdiction, as illustrated by Ruvkin, to allow system users to determine in which jurisdictions that judgments against debtors can be enforced.

Regarding Claim 2, Morris discloses a method further comprising the step of:

- requiring a client to select at least one geographic territory, said geographic territory being associated with a debtor. ("...searching the computer readable database for information corresponding to information designated by the potential buyers..." – see abstract – establishing that the client selects a criterion by which to search the bad debt. "... (e.g., by

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region, state or two-digit ZIP code)...” – see page 4, paragraph 0059 – establishing that geographic territory is a criterion and it is inherent that the geographic territory assigned to the bad debt is associated with the location of the debtor).

Morris does not teach said method comprising the steps of:

- requiring a client to select at least one geographic territory, said geographic territory being associated with a debtor, who is subject to the jurisdiction of said selected geographic territory.

Rivkin discloses said method comprising:

- a debtor who is subject to the jurisdiction of said selected geographic territory. (see Enforcement of Judgments, paragraph 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Morris by defining geographic territories by court jurisdiction, as illustrated by Ruvkin, to allow system users to determine in which jurisdictions that judgments against debtors can be enforced.

Regarding Claim 3, Morris discloses a method, wherein:

- said bad debt is a lot package that includes a pre-grouped assortment of select information relating to at least two bad debts. (“The method of the present invention preferably comprises the principal steps of (a) creating a computer readable database comprising data pertaining to a plurality of debt accounts, each account comprising a plurality of data fields; (b)

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grouping the accounts into at least one lot based upon at least one correlation among the data in the data fields...” – see abstract);

- each bad debt has a debtor. (It is inherent that each bad debt would have a debtor);
- each of said debtors being subject to a geographic territory that is common to all of said debtors in said lot package. (“...(e.g., by region, state or two-digit ZIP code)...” – see page 4, paragraph 0059); and
- said lot package to be displayed as a distinct bad debt item on said bidding site of said online auction forum. (“...(c) searching the computer readable database for information corresponding to information designated by the potential buyers; (d) receiving one or more purchase offers for one or more lots from the potential buyers...” – see abstract – It is inherent that each lot would be displayed prior to accepting purchase offers for each lot).

Morris does not teach said method wherein:

- each of said debtors being subject to a jurisdiction of a geographic territory that is common to all of said debtors in said lot package.

Rivkin discloses said method comprising:

- debtors being subject to a jurisdiction of a geographic territory. (see Enforcement of Judgments, paragraph 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Morris by defining geographic territories by court

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jurisdiction, as illustrated by Ruvkin, to allow system users to determine in which jurisdictions that judgments against debtors can be enforced.

Regarding Claim 4 - 6, Morris discloses a method wherein:

- said bad debt item is an apportioned (carved out) bad debt. ("For example, one of the modifications a potential buyer can suggest is some type of carve out that that represents a regrouping of the accounts in the lot." – see page 5, paragraph 0066 – establishing that a bad debt item can be apportioned into another bad debt item);
- containing select information relating to a particular bad debt.
("...communicating to the buyer at least a portion of the information pertaining to the items to be offered for sale..." – see abstract);
- said apportioned bad debt comprising a fractional portion of the monetary value of the whole of said bad debt. ("...(v) the principal value of the portfolio; vi) account balances..." – see page 1, paragraph 0003 - It would be inherent that an apportioned bad debt would comprise an apportioned monetary value in comparison to the non-apportioned bad debt.);
- is to be displayed as a distinct bad debt item on said bidding site of said online auction forum. ("...communicating to the buyer at least a portion of the information pertaining to the items to be offered for sale..." – see abstract - It would be inherent that the apportioned bad debt item would be displayed as a distinct bad debt to prevent confusion with the non-apportioned bad debt item);

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- said select information relating to said bad debt item includes the uncollected monetary value of said bad debt. (“...(v) the principal value of the portfolio; vi) account balances...” – see page 1, paragraph 0003); and
- said select information relating to said bad debt item includes geographic territories. (“...(e.g., by region, state or two-digit ZIP code)...” – see page 4, paragraph).

Morris does not teach said method comprising the steps of:

- said select information relating to said bad debt item includes the geographic territories in which jurisdiction is present over said debtor.

Rivkin discloses said method comprising:

- debt item includes the geographic territories in which jurisdiction is present over said debtor. (see Enforcement of Judgments, paragraph 2 – establishing that jurisdiction is required to be obtained to enforce a judgment against a debtor).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Morris by defining geographic territories by court jurisdiction, as illustrated by Rivkin, to allow system users to determine in which jurisdictions that judgments against debtors can be enforced.

Regarding Claims 9 – 11, Morris discloses a method wherein:

- said select information relating to said bad debt item includes a predetermined minimum bid request amount (5% of seller’s minimum reserve), said online auction forum not to accept a bid for said bad debt

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item that is below said predetermined minimum bid request amount set for said same bad debt item. ("Once the seller has released the accounts for sale, the seller will preferably be able to manage each lot or sale manually or choose a variety of policy rules set for each lot or sale. For example, the seller may establish a rule that "all bids under 5% of the seller's minimum reserve will be automatically rejected but all bids above 5% will be reviewed by the seller's user chief." – see page 4, paragraph 0064);

- said select information relating to each of said bad debts in said lot package includes the uncollected monetary value of said bad debt. ("...(v) the principal value of the portfolio; vi) account balances..." – see page 1, paragraph 0003); and
- said bad debts in said lot package includes geographic territories. ("...(e.g., by region, state or two-digit ZIP code)..." – see page 4, paragraph).

Morris does not teach a method wherein:

- said bad debts in said lot package includes geographic territories in which jurisdiction is present over said debtor.

Rivkin discloses said method wherein:

- said bad debts in said lot package includes geographic territories in which jurisdiction is present over said debtor. (see Enforcement of Judgments, paragraph 2 – establishing that jurisdiction is required to be obtained to enforce a judgment against a debtor).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Morris by defining geographic territories by court jurisdiction, as illustrated by Rivkin, to allow system users to determine in which jurisdictions that judgments against debtors can be enforced.

Regarding Claim 16, Morris discloses a method wherein:

- said select information relating to said lot package includes a predetermined minimum bid request amount (5% of the seller's minimum reserve), said online auction forum not to accept a bid for said lot package that is below said predetermined minimum bid request amount set for said same lot package. ("Once the seller has released the accounts for sale, the seller will preferably be able to manage each lot or sale manually or choose a variety of policy rules set for each lot or sale. For example, the seller may establish a rule that "all bids under 5% of the seller's minimum reserve will be automatically rejected but all bids above 5% will be reviewed by the seller's user chief." – see page 4, paragraph 0064).

Regarding Claims 17 - 19, Morris discloses a method wherein:

- said select information relating to said apportioned (carved out) bad debt includes the uncollected monetary value of the apportioned fraction of said bad debt. ("For example, one of the modifications a potential buyer can suggest is some type of carve out that that represents a regrouping of the accounts in the lot." – see page 5, paragraph 0066 – establishing that a bad debt item can be apportioned into another bad debt item. "... (v) the

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principal value of the portfolio; vi) account balances...” – see page 1, paragraph 0003 - It would be inherent that an apportioned bad debt would comprise an apportioned monetary value in comparison to the non-apportioned bad debt);

- said select information relating to said apportioned (carved out) bad debt includes the uncollected monetary value of the whole of said bad debt from which said apportioned bad debt was taken. (“...(v) the principal value of the portfolio; vi) account balances...” – see page 1, paragraph 0003 - It would be inherent that an apportioned bad debt would comprise an apportioned monetary value in comparison to the non-apportioned bad debt); and
- said select information relating to said apportioned bad debt includes geographic territories (“...(e.g., by region, state or two-digit ZIP code)...” – see page 4, paragraph).

Morris does not teach a method wherein:

- said select information relating to said apportioned bad debt includes geographic territories in which jurisdiction is present over said debtor.

Rivkin discloses said method wherein:

- geographic territories in which jurisdiction is present over said debtor. (see Enforcement of Judgments, paragraph 2 – establishing that jurisdiction is required to be obtained to enforce a judgment against a debtor).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Morris by defining geographic territories by court jurisdiction, as illustrated by Rivkin, to allow system users to determine in which jurisdictions that judgments against debtors can be enforced.

Regarding Claim 21 and 23, Morris discloses a method wherein:

- said select information relating to said apportioned bad debt includes the fractional share (carved out) that was apportioned from the whole of said bad debt. ("For example, one of the modifications a potential buyer can suggest is some type of carve out that that represents a regrouping of the accounts in the lot." – see page 5, paragraph 0066); and
- said select information relating to said apportioned (carved out) bad debt includes a predetermined minimum bid request amount (5% of the seller's minimum reserve), said online auction forum not to accept a bid for said lot package that is below said predetermined minimum bid request amount set for said same apportioned bad debt. ("Once the seller has released the accounts for sale, the seller will preferably be able to manage each lot or sale manually or choose a variety of policy rules set for each lot or sale. For example, the seller may establish a rule that "all bids under 5% of the seller's minimum reserve will be automatically rejected but all bids above 5% will be reviewed by the seller's user chief." – see page 4, paragraph 0064).

Regarding Claims 28 – 30, Morris discloses a method wherein:

- said bad debt item is selected from said database for display on said bidding site. ("The method of the present invention further includes the step of searching the computer readable database for information corresponding to information designated by the potential buyers again, in FIG. 6. Potential buyers are preferably informed when at least some of the designated information has been found in the searching step." – see page 4, paragraph 0062 – establishing that bad debt items can be searched and such bad debt items are displayed to the buyer.); and
- said bad debt item is selected from said database for display on said bidding site. (see page 4, paragraph 0062).

Neither Morris nor Rivkin teach a method wherein:

- said bad debt item is selected from said database for display on said bidding site on the basis of its numerical positioning in relation to other said bad debt items contained in said same database;
- said bad debt item is selected from said database for display on said bidding site on the basis of a random selection process, said random selection process occurring irrespective of the numerical positioning of any said bad debt item contained in said same database; and
- said bad debt item is selected from said database for display on said bidding site on the basis of an order preference of personnel managing said online auction forum.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Morris and Rivkin to allow for any organization and search strategy of the database that the inventor desired.

Regarding Claim 31, Morris discloses a system comprising:

- a remote host system (see 16, figure 1) connected to a communications network (internet – see 22, figure 2), said remote host-system including:
 - (i) a central processing element (CPU - see 28, figure 2) for processing data;
 - (ii) a data storage element for storing data (databases - see 30, 36, 40, 32..., figure 2); and
 - (iii) software installed for execution on the central processing element (“...a processor operatively connected to the memory, the processor programmed to...” – see Claim 30 – It is inherent that programming would consist of software) and having a database that is associated with at least one sales site module (interface – figure 2), said database including at least one bad debt item (databases – see 40 and 48, figure 2), said bad debt item being accessible on said associated sales site module in accordance with geographic territory related to a debtor (“...(e.g., by region, state or two-digit ZIP code)...” – see page 4, paragraph), said software configured to run multiple, concurrent, and distinct client sessions on said remote host system (It is inherent that

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software allows multiple, concurrent (multiple clients can have sessions simultaneously) and distinct client sessions.), and

- (b) an interface element (interface – see figure 2) for providing public access to said software, wherein a plurality of clients may each participate in an online session of said software, running on said remote host system (see 16, figure 1), from client systems connected to said communications network (internet – see 22, figure 2), and wherein each of said plurality of clients may be able to purchase said bad debt item available for sale on said associated sales site.

Morris does not teach a system comprising:

- a geographic territory where jurisdiction is present over a debtor.

Rivkin discloses said system wherein:

- a geographic territory where jurisdiction is present over a debtor. (see Enforcement of Judgments, paragraph 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Morris by defining geographic territories by court jurisdiction, as illustrated by Rivkin, to allow system users to determine in which jurisdictions that judgments against debtors can be enforced.

Regarding Claim 32, Claim 32 recites similar limitations to Claim 1 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 1. Claim 32 differs from Claim 1 in that Claim 32 refers to an “outright sale” rather than an “auction”, however “outright sales” are a well known and notorious method of

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conducting sales in the industry and it would have been within the level of ordinary skill in the art at the time the invention was made to have modified Morris to conduct an “outright sale” rather than an “auction.”

Regarding Claim 33, Morris discloses a computer-assisted method comprising:

- compiling information (creating database comprising data) relating to at least one bad debt (debt accounts), said bad debt being associated with a debtor (“debtor associated with account” – see p. 5, para. 67). (see abstract);
- the compiled information including a geographic location (geographic origin) of the debt account. (see p. 1, para. 3);
- storing compiled information (data) relating to at least one bad debt (debt accounts) in a computerized database (database). (see abstract);
- allowing a potential purchaser of bad debts (debt accounts) to specify at least one geographical location (geographic origin) of interest. (see p. 1, para. 3. “searching the computer readable database for information corresponding to information designated by potential buyers.” – see abstract);
- locating bad debts (debt accounts) stored in the computerized database for which the geographic location (geographic origin) specified (designated) by the potential purchaser corresponds with the stored geographical location (geographic origin). (see p. 1, para. 3. “searching

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the computer readable database for information corresponding to information designated by potential buyers.” – see abstract);

- providing the potential purchaser with information from the computerized database (database) relating to a bad debt (debt account) for which the stored geographic location (geographic origin) corresponds to the geographic location (geographic origin) specified (designated) by the potential purchaser. (see p. 1, para. 3. “searching the computer readable database for information corresponding to information designated by potential buyers.” – see abstract. “Potential buyers are preferably informed when at least some of the designated information has been found in the searching step.” – see p. 4, para. 0062).

Morris does not teach underlined limitations - a method comprising:

- the compiled information including a geographical location wherein jurisdiction is present over the associated debtor;
- locating bad debts stored in the computerized database for which the geographic location specified by the potential purchaser corresponds with the stored geographical location wherein jurisdiction is present over the associated debtor; and
- providing the potential purchaser with information from the computerized database relating to a bad debt for which the stored geographic location wherein jurisdiction is present over the associated debtor corresponds to the geographic location specified by the potential purchaser.

Rivkin discloses said method wherein:

- a geographic territory (forum) where jurisdiction (personal jurisdiction) is present over a debtor (defendant). (see pp. 47 - 51).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Morris by incorporating into the gathered, stored and processed debt information the geographic territories possessing jurisdiction over the defendant, as illustrated by Rivkin, allowing system users to determine in which geographic territories judgments could be obtained and enforced against debtors should debt collection proceed to litigation.

Regarding Claim 34, Morris discloses a method further comprising:

- providing the potential purchaser with information compiled in the computerized database relating to a plurality (lot) of bad debts (debt accounts) for which the stored geographical location (geographic origin) corresponds to the geographical location (geographic origin) specified (designated) by the potential purchaser. ("Potential buyers are preferably informed when at least some of the designated information has been found in the searching step." – see p. 4, para. 0062. "The step of grouping the lots preferably further includes the step of receiving from the seller at least one criterion upon which the accounts are to be grouped into lots." – see p. 4, para. 0059).

Morris does not teach underlined limitations - a method comprising:

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- providing the potential purchaser with information compiled in the computerized database relating to a plurality of bad debts for which the stored geographical location wherein jurisdiction is present over associated debtors corresponds to the geographical location specified by the potential purchaser.

Rivkin discloses said method wherein:

- a geographic territory (forum) where jurisdiction (personal jurisdiction) is present over a debtor (defendant). (see pp. 47 - 51).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Morris by incorporating into the gathered, stored and processed debt information the geographic territories possessing jurisdiction over the defendant, as illustrated by Rivkin, allowing system users to determine in which geographic territories judgments could be obtained and enforced against debtors should debt collection proceed to litigation.

Regarding Claim 35, Claim 35 recites similar limitations to Claim 21 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 21.

Regarding Claims 36 - 37, Morris discloses a method wherein:

- said potential purchaser purchases the bad debt (debt accounts). (see abstract); and
- said purchase is internet-based (see fig. 2).

Regarding Claim 38, Claim 38 recites similar limitations to Claims 33 – 34, in combination, and is therefore rejected using the same art and rationale as applied in the rejection of Claims 33 – 34, in combination.

Regarding Claim 40, Claim 40 recites similar limitations to Claim 17 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 17.

Regarding Claim 41, Claim 41 recites similar limitations to Claims 34 and 36, in combination, and is therefore rejected using the same art and rationale as applied in the rejection of Claims 34 and 36, in combination.

Regarding Claim 42, Claim 42 recites similar limitations to Claim 37 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 37.

Regarding Claims 43 – 44, Morris discloses a system wherein:

- said purchase is conducted via an auction (bidding) process. (p. 6, para. 78 – p. 7, para. 83); and
- said software further includes a purchased items database (sale database), said bad debt item (debt accounts) classified into said purchased items database (sale database) subsequent to being sold. (see p. 5, para. 0075).

Regarding Claim 45, Claim 45 recites similar limitations to Claim 38 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 38.

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Regarding Claim 47, Morris discloses a method comprising:

- gathering debt information (data) about a plurality (lot) of uncollected debts (debt accounts), each of said plurality of uncollected debts (debt accounts) being associated with a debtor. ("debtor associated with account" – see p. 5, para. 67.) (see p. 4, para. 59);
- gathering debtor information (data) regarding geographic territories (geographic origin) of debt account. (see p. 1, para. 3);
- storing the gathered debt information (data) in a computer storage element (database). (see abstract);
- allowing a client to specify (designate) a geography territory (geographic origin) of interest. (see abstract and p. 1, para. 3); and
- providing (informing) said client with information from said computer storage element (database) relating to at least one uncollected debt (debt account) for the geographic territory (geographic origin) specified (designated) by the client. (see p. 4, para. 0062).

Morris does not teach underlined limitations - a method comprising:

- gathering debtor jurisdiction information regarding geographic territories in which the debtor associated with each of such uncollected debts is likely to be subject to personal legal jurisdiction;
- storing the gathered debt information and gathered debtor jurisdiction information in a computer storage element; and

- providing said client with information from said computer storage element relating to at least one uncollected debt for which the corresponding debtor is subject to the personal jurisdiction within the geographic territory specified by the client.

Rivkin discloses said method wherein:

- a geographic territory (forum) where jurisdiction (personal jurisdiction) is present over a debtor (defendant). (see pp. 47 - 51).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Morris by incorporating into the gathered, stored and processed debt information the geographic territories possessing jurisdiction over the defendant, as illustrated by Rivkin, allowing system users to determine in which geographic territories judgments could be obtained and enforced against debtors should debt collection proceed to litigation.

Regarding Claims 48 - 49, Claims 48 - 49 recite similar limitations to Claims 19 - 20 and are therefore rejected using the same art and rationale as applied in the rejection of Claims 19 - 20.

Regarding Claim 50, Morris discloses a method wherein:

- said client purchases at least one uncollected debt (debt account).
(see abstract).

Regarding Claims 53, Morris discloses a method comprising:

- gathering debt information (data) about a plurality (lot) of uncollected debts (debt accounts). (see p. 4, para. 59);

- gathering, for each such uncollected debt (debt account), debtor information (data) regarding geographic territories (geographic origin) of debt account. (see p. 1, para. 3);
- storing the gathered debt information (data) in a computer storage element (database). (see abstract);
- allowing a client to specify (designate) a geography territory (geographic origin) of interest. (see abstract and p. 1, para. 3); and
- providing (informing) said client with information from said computer storage element (database) relating to at least one uncollected debt (debt account) for the geographic territory (geographic origin) specified (designated) by the client. (see p. 4, para. 0062).

Morris does not teach underlined limitations - a method comprising:

- gathering, for each such uncollected debt, debtor property information regarding the geographic location of property that is owned by the debtor associated with each such uncollected debt, and against which property a legal judgment may be levied;
- storing the gathered debt information, and the gathered debtor property information, in a computer storage element; and
- providing said client with information from said computer storage element relating to at least one uncollected debt for which the corresponding debtor owns property against which a legal judgment may be levied within the geographic territory specified by the client.

Rivkin discloses said method wherein:

- geographic location (jurisdiction) of property (assets) that is owned by debtor associated with each such uncollected debt (judgment), and against which property (assets) a judgment may be levied (enforced), (see p. 51, Enforcement of Judgments).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Morris by incorporating into the gathered, stored and processed debt information the geographic territories possessing jurisdiction over the defendant's assets, as illustrated by Rivkin, allowing system users to determine in which geographic territories judgments could be obtained and enforced against debtors should debt collection proceed to litigation.

Regarding Claim 54, Claim 54 recites similar limitations to Claims 50 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 50.

Regarding Claim 55, Claim 55 recites similar limitations to Claims 37, 47 and 50, in combination, and are therefore rejected using the same art and rationale as applied in the rejection of Claims 37, 47 and 50, in combination.

Regarding Claim 56, Claim 56 recites similar limitations to Claim 43 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 43.

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Regarding Claim 57, Morris discloses a method wherein software further includes at least one sale site module. (It is inherent that Morris has a sale site module since Morris conducts sales on the internet).

Regarding Claims 58 – 60, Claims 58 – 60 recite similar limitations to Claim 32 and are therefore rejected using the same art and rationale as applied in the rejection of Claim 32.

Regarding Claim 61, Claim 61 recites similar limitations to Claim 36 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 36.

Regarding Claims 62 - 64, Claims 62 - 64 recite similar limitations to Claim 38, in part, and is therefore rejected using the same art and rationale as applied in the rejection of Claim 38, in part.

Claims 7, 12 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris and Rivkin, as in Claims 1, 3 and 4 above, in further view of Yeazell (Yeazell, Stephen C. *Civil Procedure 4th Edition*. Little, Brown & Company. 1996. pp. 98 – 99).

Morris discloses a method wherein:

- said select information relating to said bad debt item includes geographic location. (“... (e.g., by region, state or two-digit ZIP code)...” – see page 4, paragraph);

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- said select information relating to each of said bad debts in said lot package includes geographic location. (“...(e.g., by region, state or two-digit ZIP code)...” – see page 4, paragraph); and
- said select information relating to said apportioned bad debt includes geographic location. (“...(e.g., by region, state or two-digit ZIP code)...” – see page 4, paragraph).

Neither Morris nor Rivkin teach a method wherein:

- said select information relating to said, bad debt item includes the geographic location where said debtor is domiciled;
- said select information relating to each of said bad debts in said lot package includes geographic location where said debtor is domiciled; and
- said select information relating to said apportioned bad debt includes the geographic location where said debtor is domiciled.

Yeazell discloses a method wherein:

- the geographic location where said debtor is domiciled. (“An analogous rule applies to the domicile (place of permanent residence) for individuals...Domicile in the state is alone sufficient to bring an absent defendant within the reach of the state’s jurisdiction...The state which accords him privileges and affords protection to him and his property by virtue of his domicile may also exact reciprocal duties...One such incident of domicile is amenability to suit within the state.” – see p. 99).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Morris and Rivkin by defining geographic territories by domicile, as illustrated by Yeazell, to allow system users to determine in which jurisdictions, as defined by the debtor's domicile, that judgments against debtors can be enforced.

Claims 8, 13 – 15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris and Rivkin, as in Claims 1, 3 and 4 above, in further view of Keyes (US Patent 6,456,983).

Regarding Claims 8 and 13 – 15, neither Morris nor Rivkin teach a method wherein:

- said select information relating to said bad debt item includes rating information that is related to the potential for collection of said bad debt item from said debtor;
- said select information relating to each of said bad debts in said lot package includes rating information that is related to the potential for collection of said bad debt from said debtor;
- said select information relating to said bad debts in said lot package includes rating information that is related to the potential for collection of all of said bad debts included in said lot package; and
- said rating information is based on an average of the total sum of a rating figure of each of said bad debts included in said lot package .

Keyes discloses a method wherein:

- said select information relating to said bad debt item includes rating information that is related to the potential for collection of said bad debt item from said debtor. (“...historical delinquent accounts are scored...” – see abstract and “Each delinquent account may be "scored", and the "score" of a particular current delinquent account may be reflective of a payment which would be projected to be received in relation to this particular delinquent account, based upon a statistical analysis of sorts.” – see col. 2, lines 48 – 53);
- said select information relating to each of said bad debts in said lot package includes rating information that is related to the potential for collection of said bad debt from said debtor. (supra);
- said select information relating to said bad debts in said lot package includes rating information that is related to the potential for collection of all of said bad debts included in said lot package (supra); and
- said rating information is based on an average of the total sum of a rating figure of each of said bad debts included in said lot package . (“An average score identifier 26 may be provided if desired for each of the historical portfolio groups 91, which would be the average score 40 of the various historical delinquent accounts 90 contained within the subject historical portfolio group 91.” – see col. 7, lines 11 – 15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Morris and Rivkin by incorporating into the select

information linked to a bad debt item a rating related to the potential for collection, as disclosed by Keyes, to provide bidder with the ability to gauge the possibility that bidder will be able to collect on bad debt item.

Regarding Claims 22, Morris discloses a method wherein:

- said select information relating to said apportioned (carved out) bad debt.

Neither Morris nor Rivkin disclose a method wherein:

- said select information relating to said apportioned bad debt includes rating information that is related to the potential for collection of said apportioned bad debt from said debtor.

Keyes discloses a method wherein:

- said select information relating to said bad debt includes rating information that is related to the potential for collection of said bad debt item from said debtor.

("...historical delinquent accounts are scored..." – see abstract);

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Morris and Rivkin by incorporating into the select information linked to a bad debt item a rating related to the potential for collection, as disclosed by Keyes, to provide bidder with the ability to gauge the possibility that bidder will be able to collect on bad debt item.

Claims 24 – 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris and Rivkin, as in Claim 1 above, in further view of Atkinson (US Patent Pub. 2001/0021923).

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Morris discloses a method wherein:

- said bad debt item that receives a bidding price equal to or above its predetermined minimum bid request amount will be classified into a purchased items database of said online auction forum. ("In another embodiment, the method of the present invention may preferably include the steps of recording data relating purchase offers made by potential buyers into a computer readable purchase offer database. This data may preferably be utilized to gauge current and/or historical market demand for the purpose of grouping accounts into lots conforming to the market demand." – see page 5, paragraph 0074).

Neither Morris nor Rivkin teach a method wherein:

- said bad debt item that receives a bidding price equal to or above its predetermined minimum bid request amount at the end of said bidding phase interval will be classified into a purchased items database of said online auction forum; and
- said online auction is conducted utilizing consecutive and concurrent bidding phase intervals, each of said bidding phase intervals enduring for a predetermined time period.

Atkinson discloses a method wherein:

- said online auction is conducted utilizing consecutive and concurrent bidding phase intervals, each of said bidding phase intervals enduring for a predetermined time period. ("In such auctions, various goods or services may simultaneously be placed for auction. In certain situations, however, there is a

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need to provide two or more auctions falling chronologically one after another.

Each such auction falling in chronological order is referred to herein as an 'auction round.' " – see page 1, paragraph 0012).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Morris and Rivkin by incorporating bidding intervals, as disclosed by Atkinson, to provide flexibility to organization of the online auctions.

Response to Arguments

Regarding rejections of Claims 33 – 35, 37 – 40, 42, 45 and 58 – 59 under §101, applicant amended Claims to comply with §101. Examiner withdraws rejection based upon §101.

Regarding rejection of Claims 1 – 6, 9 – 11, 16 – 19, 21, 23, 28 – 45 and 53 under §103, the applicant argues that Morris in view of Rivkin fails to suggest "classifying bad debt items based upon a geographic territory where jurisdiction is present over a debtor." In particular, applicant argues:

- Rivkin states that "the overwhelming majority of financial cases brought in the US settle before trial, making enforcement of judgments a little-used tool";
- Rivkin's discussion is directed to the enforcement of a "judgment", which presupposes a judgment has already been obtained against the debtor; and
- Rivkin quotation relates to a jurisdiction in which judgment debtor has "real property, equipment, fixtures and personal property," rather than a

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geographical territory in which the debtor himself is subject to personal jurisdiction.

Examiner disagrees.

While enforcement of judgments, according to Rivkin, may be a "little-used tool," enforcement of judgments is known, as Rivkin indicates that there are "those cases that are litigated to conclusion" (see p. 51, Enforcement of Judgments).

Furthermore, Rivkin also states:

"Like most courts, US courts are empowered to decide a case only if they have jurisdiction over the defendant." In the US, personal jurisdiction has both a constitutional dimension, applicable in all courts, and a statutory dimension, which varies from state to state.

Under the US Constitution, a court may exercise jurisdiction over a defendant only if there are meaningful minimum contacts between the defendant and the forum. In cross-border financial cases, such contacts can arise in two different ways. First, if a defendant does substantial and continuous business in a US state, the courts of that state have jurisdiction over the defendant with respect to any and all claims, whether or not related to the defendant's US business. Secondly, if a defendant commits an act in a US' state, the state has jurisdiction over the defendant, but only with respect to claims relating to that act." (see p. 48, emphasis added).

Rivkin reveals that a defendant to litigation, such as a debtor, would be subject to personal jurisdiction of a court based upon the defendant's contact with a geographical territory, such as the forum. The geographic territory in which the court resides would therefore, define the extent of the court's personal jurisdiction over the defendant. Since a court would only be empowered to decide a case against the defendant and issue a judgment if the court had personal jurisdiction over said defendant it would have been obvious to one of ordinary skill in the art to have classified bad debt accounts by the geographic territories having personal jurisdiction over a debtor, alerting potential purchasers of the

bad debt accounts the geographical territories in which the debtor would be a jurisdictionally reachable defendant should collection on bad debt accounts lead to litigation.

While the quotation relates to enforcement of a judgment, personal jurisdiction, as disclosed by Rivkin, would be required to obtain said judgment. After judgment is obtained, the judgment must then be enforced against the defendant. This enforcement could be obtained against the defendant himself, such as through garnishment (see p. 51, Enforcement of Judgments), or against the defendant's property, such as through seizure and sale (see p. 51, Enforcement of Judgments). The intent of the quotation was to emphasis that a court with jurisdiction was required to enforce the judgment, in addition to obtaining said judgment, when and if a judgment was obtained.

The jurisdictional requirements for enforcement of a judgment against the property of a defendant would have made it obvious to one of ordinary skill in the art to have further classified bad debt accounts by the geographic territories having jurisdiction over a debtor's property, altering potential purchasers of bad debt accounts the geographical territories in which the debtor's property would be jurisdictionally reachable should enforcement of a judgment against the debtor's property need to take place.

Regarding rejection of Claims 7, 12 and 20 under § 103, the applicant argues that Morris and Rivkin in view of Yeazell fails to suggest "that the gathered information about or more bad debts include the geographic location

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where said debtor is domiciled." In particular, applicant argues that Yeazell "is merely stating a basic principle of civil judicial procedure" and that "hardly constitutes a suggestion to modify Morris." Furthermore, applicant argues improper hindsight on Examiner's behalf. Examiner disagrees.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Morris discloses "a method and system for facilitating a sale of debt accounts." (see abstract). Rivkin discloses the obtainment of personal jurisdiction by a court over the defendant for "financial litigation". (see p. 47, Introduction). As owners of debt accounts may require litigation to recover funds from defaulted debtors, it would have been obvious to one of ordinary skill in the art at the time the invention was made to classify debt accounts by the geographic region that possessed jurisdiction over the debtor, who may be a potential future defendant to litigation.

Rivkin discloses that personal jurisdiction over a defendant requires "minimum contacts between the defendant and the forum." (see p. 48). Yeazell states that the minimum contacts standard is not required in the forum in which a

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defendant is domiciled as "[d]omicile in the state is alone sufficient to bring an absent defendant within reach of the state's jurisdiction." (see p. 99).

While Yeazell, as the applicant contends, does not discuss "judgment debtors, debt collection or marketing of bad debts," in conjunction with Morris and Rivkin, it would seem obvious that if one was to classify bad debt accounts based upon personal jurisdiction that one would record information concerning domicile as domicile is alone sufficient to obtain personal jurisdiction over said defendant.

Regarding rejections based upon § 103, the applicant argues improper use of hindsight. The examiner disagrees.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (703) 308-9552. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (703) 308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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